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10/635,925	08/05/2003	Richard Hull	B-5190 621139-0	1058

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P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CAI, WAYNE HUU

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/635,925
Filing Date: August 05, 2003
Appellant(s): HULL ET AL.

Robert Popa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 20, 2008 appealing from the Office action mailed August 22, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 1-7, 9-22, and 24-30, the phrase "likely to be holding" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

The Examiner notes that "*likely to be holding*" could render the claim indefinite because the mobile device is not necessary holding any data item. More importantly, the Applicant's specification does not specify how "likely" to consider that the mobile device is likely to be holding the data item (i.e., based on time, distance, etc.)

Allowable Subject Matter

Claims 1-7, 9-22, and 24-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

(10) Response to Argument

Issue 1: Claims 1-7, 9-22, and 24-30 are indefinite in view of 35 U.S.C § 112, second paragraph.

As stated by the Appellant at page 4, the Examiner insists his opinion that the phrase “likely to be holding” renders the claims indefinite because the mobile device is not necessarily holding any data item. More importantly, the Appellant’s specification does not specify how “likely” to consider the mobile device is likely to be holding the data item. The Examiner still maintains this ground of rejections and further detailed explanation is accompanied herewith.

Firstly, the Examiner thanks the Appellant for providing the definition of “likely” both in the Remarks dated July 30, 2007 and again in the Argument section of this Appeal Brief.

Likely is defined as **having a chance of happening or being true**. (The American Heritage® Dictionary of the English language, Fourth Edition Copyright © 2007, 2000 by Houghton Mifflin Company).

Based on the above definition of “likely”, both one skilled in the art and the Examiner would interpret the phrase “likely to be holding the data item” of claimed

limitation as **having a chance of holding the data item**. Since claims recite the mobile device has a chance of holding the data item; it also means that the mobile device might or might not hold the data item or the mobile device probably holds the data item, but it is unnecessary that the mobile device does actually hold the data item. Clearly, the phrase “likely to be holding the data item” renders the scope of the claims unascertainable.

The Appellant further states at the last paragraph of page 4 to page 5 that – keeping a record on an on-going basis of which mobile devices in said space, if any, hold or have a chance of holding the data item – is indeed one of the inventive notions in the claimed invention. The Examiner respectfully agrees with the Appellant that this is one of the inventive notions. However, according to 35 U.S.C. 112 Specification, the specification is required to contain a written description of the invention, and of the manner and process of making and using it, in such a full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Therefore, the Appellant is required to clearly, positively, and concisely defines the claimed limitation, specifically, the phrase “likely to be holding the data item”. In other words, the Appellant must positively sets forth criteria, conditions both in the specification and in the claim language that how “likely” is considered as likely to be holding the data item. Based purely on the phrase “likely to be holding the data item” as set forth in claim language, without setting a specific conditions or criteria, one skilled in

the art would not be able to conceptualize or be able to decide for themselves, without undue experimentation, how likely they want a mobile device to be considered as likely to be holding data item. For example, the Appellant needs to specify that when the mobile device is located in the certain area, the mobile device has certain level of signal strength, or the mobile device at a specific distance apart from other mobile devices or database, then this mobile device could be considered as likely to be holding the data item.

Furthermore, the Appellant asserts at the second full paragraph of page 5 that claim 10, inter alia, teaches the skilled and careful reader that said on-going record keeping of which mobile devices are likely to be holding the data item comprises at least the first one of periodically making an inventory of items currently held by each mobile device and recording incremental changes to the inventory of each mobile devices as items are added/removed. The Examiner respectfully notes that claim 10 rather recites “said on going record keeping comprises at least the first one of periodically making an inventory of items currently held by each mobile device and recording incremental changes to the inventory of each mobile devices as items are added/removed.” **Claim 10 does not recite said on-going record keeping of which mobile devices are likely to be holding the data item** comprises all the limitations recited within claim 10, as stated by the Appellant. Therefore, the Examiner is not allowed to interpret and/or considered phrases that are not recited within claim itself.

More importantly, claim 10 clearly defines the claimed invention by reciting that “periodically making an inventory of items currently held by each mobile device”. It also

means that keeping record of which mobile device is either holding or not holding the data item, but not the mobile device is likely to be holding the data item, has a chance of holding the data item, or probably holding the data item.

Lastly, the Appellant states at the last three full paragraphs of page 6 to page 7 that “the fact that there are may be a chance the mobile device is not holding the data item simply means that the probability of the mobile holding the data item is less than one. How does this have anything to do with the ability of the skilled person to ascertain whether the mobile device has a chance of holding the item that is greater than zero?”

The Examiner respectfully notes that the Examiner does not mention anything in the Office Action related to the ability of the skilled person to ascertain whether the mobile device has a chance of holding the data item that is greater than zero. Rather, the Examiner simply made a statement in the Office Action stating that one skilled in the art and/or the Examiner would conceptualize the phrase “likely to be holding data item” as **having a chance of holding the data item, probability of the mobile holding the data item.** That is, the mobile device could or could not hold the data item. It also means that there is a possibility that the mobile device is holding or not holding the data item at all. Since the phrase “likely to be holding” is interpreted as having a chance of holding the data item, and it really means that the chance or the probability of the mobile device holding the data item could be equal to zero or greater than zero.

In general, both the Appellant and the Examiner agrees that “likely to be holding” is having a chance, having a probability of the mobile device holding the data item. The Appellant agrees this interpretation throughout all the responses in the past and in this

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Appeal Brief, and the Examiner certainly agrees with these statements. Since the Appellant does not positively define the claimed limitation so that one skilled in the art and/or the Examiner to be able to ascertain the scope of the claimed invention, then these claims must be maintained as the rejections for being indefinite.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Wayne Cai/

Conferees:

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/William Trost/

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